

REMARKS

The Office Action mailed March 19, 2003, has been carefully considered. A substitute Abstract and Figure 6 are submitted herewith. The present amendment is intended to be a complete response thereto and to place the case in condition for allowance. Claims 11, 17, 19, and 22-24 have been amended. Claims 11-25 are pending.

THE CLAIMS ARE NOT INDEFINITE

Claims 11-24 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Applicant respectfully traverses the rejection.

With regard to claims 11 and 22-24, the Examiner alleges that the recitation of the leg ends being “capable of reversible temporary engagement” is confusing in that it is unclear how the ends can be reversible. Applicant has amended claims 11 and 22-24 to delete the word “temporary”. The claim now reads “capable of reversible engagement”. This phrase, particularly the word “reversible”, is intended to indicate full recovery of shape after engagement of the leg ends under manually exerted pressure. For example, when manufacturing a pair of tweezers from a light metal in the same manner as used for production of steel tweezers (point welding of two blades), the resulting tweezers tend to become deformed and shape deformation is not fully reversible. In other words, it is not the ends of the tweezers that are reversible, but the shape of the pair of tweezers.

With regard to claims 14 and 15, the Examiner alleges that “said apex area” lacks antecedent basis. Claim 1 has been amended to provide antecedent basis for “said apex area” in claims 14 and 15.

With regard to claims 17 and 19, the Examiner alleges that “said first thickness” lacks antecedent basis. The word “[s]aid” in claims 17 and 19 has been amended to read -- a --. Therefore, for the reasons above, the claims are now definite.

THE CLAIMED INVENTION WOULD NOT HAVE BEEN OBVIOUS

Claims 11-16 and 22-25 stand rejected under 35 U.S.C §103(a) as being obvious over Sergeant (U.S. Patent No. 4,387,610) in view of Kaufman (U.S. Patent No. 5,192,106). Claim 22 stands rejected under 35 U.S.C §103(a) as being obvious over Seyfriedt or JP 1-257571 (JP ‘571). Claim 23 stand rejected under 35 U.S.C §103(a) as being obvious over Seyfriedt in view of GB 2 035 187 (GB ‘187). Applicant respectfully traverses the rejections.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP 2143.

With regard to the rejection of claims 11-16 and 22-25 over Sergeant in view of Kaufman, the references, taken alone or in combination, fails to disclose every element of the invention as claimed. Sergeant discloses a “force applying tool” which has no “legs” that can be brought into reversible engagement. The tool of Sergeant operates as a ram so that when manual pressure is exerted to the sides 12, 14, the movable end or “jaw” 4 is forced into the fixed jaw 2. This tool has nothing in common with a pair of tweezers.

Kaufman discloses a device for handling compact discs (CDs), either by gripping a CD at its outer periphery or at the central hole. In either case, the legs or arms of the Kaufman device are not intended for, nor capable of, operation as a pair of tweezers. The two ends positions of the arms of the Kaufman device are shown in Fig. 16. Closure of the ends is neither required or desired.

The gripping ends of the Kaufman device are illustrated in Fig. 14 and it is apparent that one could not use that device as a pair of tweezers, e.g. for pulling out a hair, and the arms of the Kaufman device would become permanently deformed if firmly pressed together at the grip ends (intended to manipulate CDs as softly as possible to void damage thereof). Thus, the arms of the Kaufman device cannot be in reversible engagement.

Because neither Sergeant nor Kaufman discloses a pair of tweezers nor teaches a particular tweezers structure, their combination cannot result in the tweezers of the present invention, or any other tweezers for that matter. The Examiner's statement that "Sergeant shows a pair of tweezers" (page 2, last paragraph, of the Office Action) is not support by fact. Neither is the Examiner's statement that "Kaufman shows a "one-piece tweezers device" (page 3, first paragraph, of the Office Action). All references to "sergeant's tweezers" on page 3 are in no way support by what is shown and taught in the reference.

Further, Sergeant teaches away the present invention. Sergeant explicitly states that the "force applying tool" is made of plastic. So, even if Sergeant would disclose tweezers (which the reference unequivocally does not), it is a very far cry from the extrusion of plastics to extrusion of light metal.

With regard to the rejection of claim 22 over either Seyfriedt or JP '571, the references, taken alone or in combination, fails to disclose every element of the invention as claimed.

Neither reference teaches tweezers made of a light metal. Replacement of conventional metals (i.e. steel) for tweezers by light metal, such as aluminum, is by no means obvious and more than ordinary skill is needed to provide light metal tweezers having a closing pressure of above 100 grams. The Examiner appears to have misunderstood the significance of such closing pressures. It is very easy to make tweezers of any material and shape if a low closure pressure would suffice. In fact, light metal tweezers capable of replacing steel tweezers (which have closure pressure of above 100 grams) require such a relatively high closure pressure that, prior to the present invention, it is anything but obvious to achieve.

With regard to the rejection of claim 22 over Seyfriedt in view of GB '187, the references, taken alone or in combination, fails to disclose every element of the invention as claimed. Neither reference teaches tweezers made of a light metal. The deficiency of Seyfriedt is discussed above. GB '187 discloses forceps that are made of plastics (page 1, lines 44-45) which precludes the high closing pressure of the present invention. In fact, GB '187 mentions "a certain amount of stiffness" resulting from the "web 16" but immediately points out that this is intended to avoid "crossing of the tips" (page 1, lines 73-78). This implies a very soft structure precluding a closing pressure comparable to that of steel tweezers or that of the present invention.

For the reasons given, the Examiner fails to make a *prima facie* case of obviousness because the references, taken alone or in combination, fails to disclose every element of the presently claimed invention. Therefore, the claims are not obvious under the meaning of 35 U.S.C §103(a). Accordingly, the rejection should be withdrawn.

ALLOWABLE SUBJECT MATTER

Applicant gratefully acknowledges the Examiner indicating claim 17-21 allowable if rewritten to over come the rejections under 35 U.S.C §112, second paragraph, and to include all the limitation so of the base claim and any intervening claims.

THE ABSTRACT IS IN PROPER FORMAT

The Abstract stands objected to because it contains “legal phraseology such as ‘said’ in the last line”. A new abstract is submitted herewith to replace the original abstract. The word “said” in the abstract has be replaced with “the” in the new abstract. Therefore, Applicant respectfully submits that the new abstract is in proper format.

DRAWINGS

The drawings stand objected to under 37 C.F.R. 1.83(a) because they fail to show Figure 6 as described in the specification. Figure 6 is submitted herewith. Figure 6 has support in the parent PCT application (PCT/CH00/00441) which published as WO 01/13756. Therefore, it is believed that no new matter is present.

CONCLUSION

Applicant has responded to the Office action mailed March 19, 2003. A substitute Abstract is submitted herewith. All pending claims are now believed to be allowable and favorable action is respectfully requested.

In the event that there are any questions relating to this Amendment or to the application in general, it would be appreciated if the examiner would telephone the undersigned attorney concerning such questions so that the prosecution of this application may be expedited.

Please charge any shortage or credit any overpayment of fees to BLANK ROME LLP, Deposit Account No. 23-2185 (000364-00123). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this response, applicant hereby petitions under 37 C.F.R. 1.136(a) for an extension of time for as many months as are required to render this submission timely.

Any fees due are authorized above.

Respectfully submitted,



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